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MORRISON & FOERSTER LLP 1650 TYSONS BOULEVARD SUITE 400 MCLEAN, VA 22102			EXAMINER TRAN, QUOC A	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/799,607
Filing Date: March 15, 2004
Appellant(s): YASUDA ET AL.

MAILED

OCT 05 2007

Technology Center 2100

Alex Chartove
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/26/2007 appealing from the Office action mailed 12/07/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US20010016856	Tsuji et al.	Filed 01/30/2001
US 20040172595A1	Lerner et al.	Filed 03/03/2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

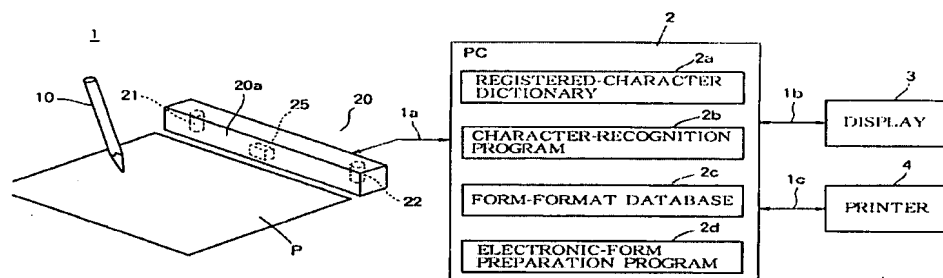
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 7 rejected under 35 U.S.C. 102(b) as being anticipate by Tsuji et al.
US 20010016856A1 filed 01/30/2001 (hereinafter [Tsuji]).

Regarding independent claim 1, Tsuji teaches, *a receiving terminal configured to acquire handwritten information that is handwritten on a document*. Specifically Tsuji discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form P of a predetermined format (Tsuji, page 2 para 37-39.

Fig. 1),

FIG. 1



Additionally, Tsuji teaches, *a document receiving terminal configured to receive the handwritten information that is transmitted from the receiving terminal*. For example Tsuji discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form of a predetermined format wherein the PC2 includes a character-recognition unit for recognizing characters written into the form P by the input pen 10 on the basis of coordinates supplied from the coordinate-input device 1, and an electronic-form preparation unit for preparing an electronic form using the characters recognized by the character-recognition unit. These units are realized by a registered-character dictionary 2a, a character-recognition program 2b, a form-format database 2c, and an electronic-form preparation program 2d (Tsuji page 2 para 37-40, Fig. 1).

Also Tsuji teaches, *a format storage terminal configured to store a format of the document*. For example Tsuji discloses and a format storage terminal configured to store a format of the document (Tsuji, page 2 para 42).

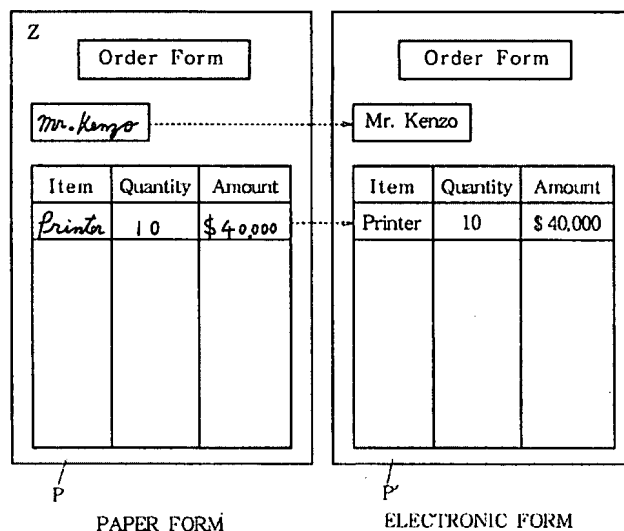
Furthermore Tsuji teaches, *wherein the receiving terminal includes: a format acquisition part, which acquires the format of the document from the format storage terminal*. For example Tsuji discloses a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format (Tsuji, page 1 para 14, and at page 2 para 42).

Additionally, Tsuji teaches, *a handwritten information acquiring part, which acquires the handwritten information that is handwritten on the document*. Specifically

Tsuji discloses an input pen including a writing member for handwriting characters into a form having a predetermined format, and a transmitter provided in the vicinity of a tip of the writing member for emitting a signal when making entries into the form by the input pen is started (Tsuji page 1, para 7, and at page 2, para 42).

Also Tsuji teaches a *handwritten information transmitting part, which transmits the handwritten information to the document receiving terminal*. For example Tsuji discloses in FIG. 6, a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (Tsuji, page 4, para 68, Fig. 6).

FIG. 6



Additionally, Tsuji teaches a *printing part, which prints the document based on the format acquired by the format acquisition part*. For example Tsuji discloses in FIG. 6 a view explaining the operation of preparing an electronic form. In FIG. 6, P represents

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a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (Tsuji, page 4 para 68, Fig. 6).

Furthermore Tsuji teaches, *the printing part prints identifier information, by which the handwritten information acquiring part identifies the document with the document.*

Specifically Tsuji discloses item P in fig. 6, which represents a form into which characters are written by the input pen item 10 in fig. 6, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer item 4 fig. 1 (Tsuji, page 4 para 68. Fig. 6, Fig. 1). Additionally, Tsuji discloses the letter Z serving as an identification ID of the form P and when the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P (Tsuji, page 4 para 68-69, Fig. 6).

Regarding independent claim 7, incorporate substantially similar subject matter as cited in claim 1 above, and is similarly rejected along the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5-6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuji, in view of Lerner et al US 20040172595A1 Division of 09/521,022 filed 03/07/2000 (hereinafter [Lerner]).

Regarding claim 3, Tsuji teaches:

wherein the receiving terminal further includes: a certifying part, which transmits and received necessary information for the certification to and from the certifying terminal,

(See Tsuji at page 4 paragraph [0068] also see Fig. 6), discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4.

an accounting process part which collects a service fee required based on printing of a publication document which is published based on an application made by the document; and a publication document information acquiring part which acquires information regarding the publication document from the document receiving terminal (see Tsuji at page 4 paragraphs [0068]-[0069] also see Fig. 6), discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4. Further Tsuji discloses the letter Z serving as an identification ID of the form P is printed beforehand at the upper left corner of the form P. When the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P. The main unit 20 determines coordinates of a series of points constituting a part of each of these entered letters or characters. These determined coordinates are stored in the data storage unit 44 in pen-stroke blocks (i.e. using the broadest interpretation the Examiner reads the above as an obvious variant as claimed).

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In addition, Tsuji does not explicitly teach, however Lerner teaches:

a certifying terminal configured to certify a user who handwrites the handwritten information on the document, certifying part which transmits and received necessary information for the certification to and from the certifying terminal,

(See Lerner at page 1 paragraph [0006] page 3 paragraph [0043] also see Fig. 3, discloses the invention relates to the integration of any annotation, including ink, highlighter, text-based notes and audio, directly into a Web-based document (WBD) displayed by a Web browser, wherein users may annotate blank WBD, effectively converting their Web browsers into online notebooks/scrapbooks that includes User password for access right.)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Tsuji's teaching, to include a means of certifying terminal configured to certify a user who handwrites the handwritten information on the document, certifying part which transmits and received necessary information for the certification to and from the certifying terminal of Lerner. One of ordinary skill in the art would have been motivated to modify this combination, because they are from the same field of endeavor of electronic document authoring, delivering, rendering, representing and executing using digital annotation (i.e. stylus, digital pen...), and provides user password for access right for security purpose (see Lerner at page 3 paragraph [0043]).

Regarding claim 5, Tsuji teaches:

*wherein the format of the document is determined by the information
regarding the certification acquired by the certifying part*

(See Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042], discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format;

further, see Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042], discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format).

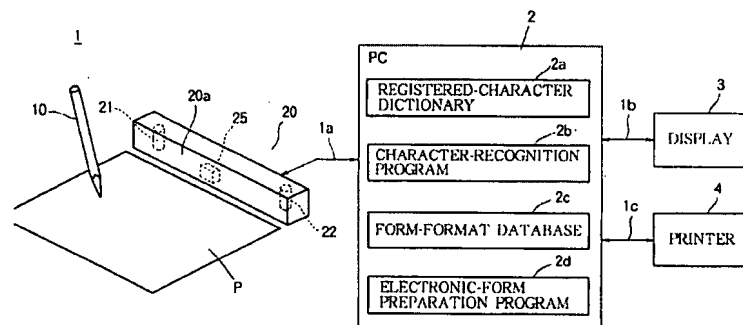
Regarding claim 6,

*wherein the handwritten information that is edited is transmitted to the
document receiving terminal with the information of the document in a case
where the certification is confirmed by the certifying part, and information about
the publication document is transmitted from the document receiving terminal to
the publication document information acquiring part*

(See Tsuji at page 1 paragraph [0014] and at page 2 paragraph [0042]), discloses and a format storage terminal configured to store a format of the document, wherein the form-format database 2c stores form-format data for various types of form having a specific format;

Also, see Tsuji at page 2 paragraphs [0037]-[0039] also see Fig. 1, discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form P of a predetermined format.

FIG. 1



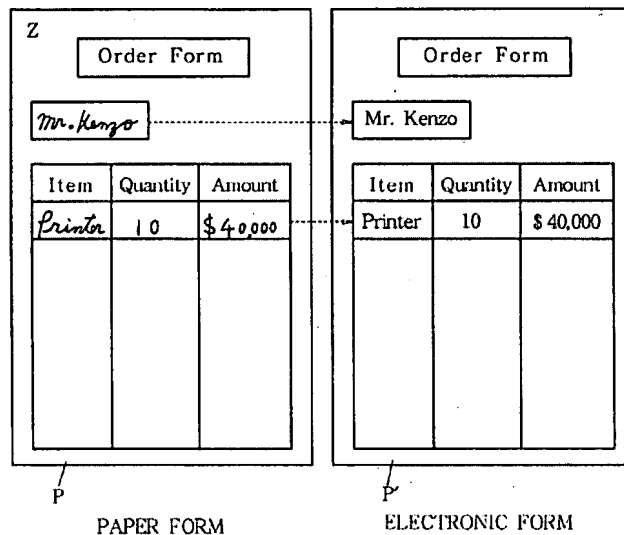
See also Tsuji at page 2 paragraphs [0037]-[0040] also see Fig. 1, discloses a pc, a display, and the coordinate-input device 1 that includes an input pen for handwriting characters into a form of a predetermined format wherein the PC2 includes a character-recognition unit for recognizing characters written into the form P by the input pen 10 on the basis of coordinates supplied from the coordinate-input device 1, and an electronic-form preparation unit for preparing an electronic form using the characters recognized by the character-recognition unit. These units are realized by a registered-character dictionary 2a, a character-recognition program 2b, a form-format database 2c, and an electronic-form preparation program 2d.

And see Tsuji at page 4 paragraph [0068] also see Fig. 6, discloses in FIG. 6 is a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an

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electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4.)

FIG. 6

**Regarding claim 9,**

incorporate substantially similar subject matter as cited in claim 3 above,
and is similarly rejected along the same rationale.

Regarding claim 10,

incorporate substantially similar subject matter as cited in claims 1, and 7
above, and is similarly rejected along the same rationale.

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Regarding claim 11,

incorporate substantially similar subject matter as cited in claims 3, and 7 above, and is similarly rejected along the same rationale.

Regarding claim 12,

incorporate substantially similar subject matter as cited in claims 3, 5 and 7 above, and is similarly rejected along the same rationale.

(10) Response to Argument

Brief description of cited prior arts:

Tsuji teaches, an electronic-form preparation system comprising a coordinate-input device and a data processor (See Tsuji Fig. 1 and also at Pg 1 Para 5), where the electronic-form preparation program displays an electronic form based on the form-format data which have been read from the form-format database *2c on the display 3*, and also displays types (characters) *corresponding to the characters handwritten into the form P by the input pen 10 in substantially real time*. The printer 4 prints an image of the electronic form displayed on the display 3 as necessary (See Tsuji at Pg 3 Para 45). For example, in Fig. 6 of Tsuji is a view explaining the operation of preparing an electronic form, where, **P** represents a form into which characters are written by the input pen 10, and **P'** represents an electronic form reflecting the entries into the form **P** and displayed on the display 3 or print out by the printer 4 (See Tsuji Fig. 6 and Pg 4 Para 68).

Lerner teaches, a Web-based document (WBD) displayed by a Web browser, where users may annotate blank WBD, effectively converting their Web browsers into online notebooks/scrapbooks that includes User password for access right (See Lerner at page 1 paragraph [0006] page 3 paragraph [0043] also see Fig. 3.).

Beginning on page 4 of the appeal brief (hereinafter the brief), Appellant argues the following issues, which are accordingly addressed below.

Firstly, Appellant argues, independent claims 1, and 7 improperly rejected under 35 USC 102 (b) rejection as anticipated by Tsuji, because Tsuji fails to teach, "*the printing part prints identifier information, with the document.*" (See the brief Pg 4 to Pg 6 and Pg 9, part of the last limitation of independent claim 1 and Pg 10 part of the last limitation of independent claim 7.)

The examiner respectfully disagrees.

Specifically, **Tsuji** teaches *a printing part*, for example Tsuji discloses in FIG. 6 a view explaining the operation of preparing an electronic form. In FIG. 6, P represents a form into which characters are written by the input pen 10, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (Tsuji, page 4 para 68, Fig. 6).

Furthermore Tsuji teaches, the printing part prints identifier information, by which the handwritten information acquiring part identifies the document with the document. Specifically Tsuji discloses item P in fig. 6, which represents a form into which characters are written by the input pen item 10 in fig. 6, and P' represents an electronic form reflecting the entries into the form P and displayed on the display 3 or print out by the printer item 4 fig. 1 (Tsuji, page 4 para 68. Fig. 6, Fig. 1).

Additionally, Tsuji discloses the letter Z serving as an identification ID of the form P and when the letter Z in the form P is traced by the input pen 10, the main unit 20 can determine the coordinates of a series of points constituting a part of the locus of the letter Z. Next, "Mr. Kenzo", "Printer", "\$4,000" are entered into boxes in the form P (Tsuji, page 4 para 68-69, Fig. 6).

Although the letter Z is printed in a paper form beforehand as a form ID, it is also possible to print four lines crossing each other in a paper form as shown in FIG. 7 to identify its form type by detecting the number of the lines traced and the tracing order. It is also possible to identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand. In this case, a specific box to filled in a form ID may be printed in the form (see Tsuji Para 82).

Also, **Tsuji** teaches, an electronic-form preparation system comprising a coordinate-input device and a data processor (See Tsuji Fig. 1 and also at Pg 1 Para 5), where the electronic-form preparation program displays an electronic form based on the form-format data which have been read from the form-format database 2c *on the display 3*, and also displays types (characters) *corresponding to the characters handwritten into the form P by the input pen 10 in substantially real time*. The printer 4 prints an image of the electronic form displayed on the display 3 as necessary (See Tsuji at Pg 3 Para 45). For example, in Fig. 6 of Tsuji is a view explaining the operation of preparing an electronic form, where, **P** represents a form (i.e. paper form) into which characters are written by the input pen 10, and **P'** represents an electronic form

reflecting the entries into the form P and displayed on the display 3 or print out by the printer 4 (See Tsuji Fig. 6 and Pg 4 Para 68).

Since Tsuji's electronic-form preparation program displays characters *corresponding to the characters handwritten into the form P by the input pen 10 in substantially real time* (i.e. character being recognized as handwritten into the form P in real time), and identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand, in order to print the a form ID, with the document.

It is noted the claimed "*the printing part prints identifier information, with the document,*" is reasonably interprets as *the characters handwritten into the form P by the input pen 10 in substantially real time* (i.e. character being recognized as handwritten into the form P in real time), and identify a form type by writing a form ID into a predetermined area of a paper form without printing a form ID beforehand, in order to print the a form ID, with the document as taught by Tsuji.

FIG. 6

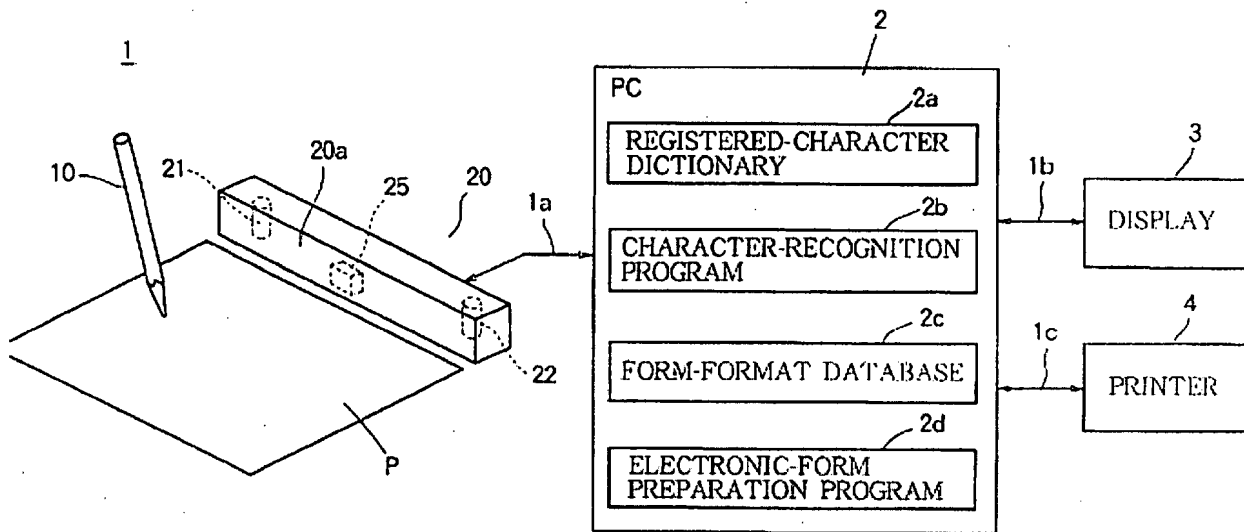
FIG. 6 illustrates two versions of an "Order Form" side-by-side, labeled "PAPER FORM" and "ELECTRONIC FORM".

PAPER FORM: The form is labeled "Z" in the top left corner. It has a title "Order Form" in a box. Below the title, the name "Mr. Kenzo" is handwritten in a box. Below the name is a table with three columns: "Item", "Quantity", and "Amount". The first row of the table contains the handwritten entries "Printer", "10", and "\$40,000".

ELECTRONIC FORM: The form is labeled "P" in the top left corner. It has a title "Order Form" in a box. Below the title, the name "Mr. Kenzo" is typed in a box. Below the name is a table with three columns: "Item", "Quantity", and "Amount". The first row of the table contains the typed entries "Printer", "10", and "\$40,000".

Dashed lines connect the handwritten "Mr. Kenzo" on the paper form to the typed "Mr. Kenzo" on the electronic form, and the handwritten "Printer" on the paper form to the typed "Printer" on the electronic form.

FIG. 1



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For at least all the above evidence, therefore the Examiner respectfully concludes that Tsuji has taught each and every limitation of independent claims 1, and 7. Therefore independent claims 1, and 7 rejected under 35 USC 102 (b) as anticipated by Tsuji is improper.

Secondly, Appellant argues, dependent claims 3, 5-6 and 9-12 improperly rejected under 35 USC 103 (a) rejection of Tsuji in view of Lerner, because Tsuji fails to teach, *"the printing part prints identifier information, with the document."* (See the brief Pg 7 and Pg 4 to Pg 6 and Pg 9, part of the last limitation of independent claim 1 and Pg 10 part of the last limitation of independent claim 7.)

The examiner respectfully disagrees.

As discuss in the above (see the current Examiner Answer Pg 15-16), the Examiner has established evidence of Tsuji has taught the printing part prints identifier information, with the document as claimed by the Appellants claimed invention. Thus, accordingly, the Examiner has established a prima facie obviousness rejection of independent claims 3, 5-6 and 9-12.

Therefore the Examiner respectfully maintains the rejection of claims 1, 3, 5-7 and 9-12, and should be sustained.

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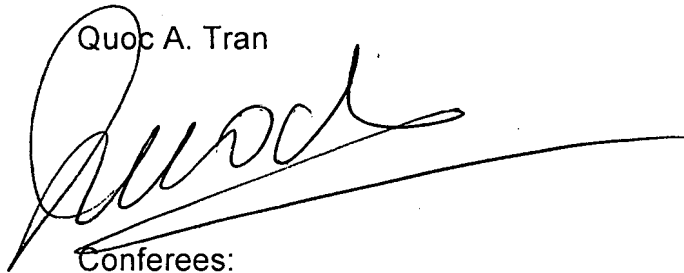
(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Quoc A. Tran

A handwritten signature in black ink, appearing to read 'Quoc A. Tran', with a long horizontal line extending from the end of the signature.

Conferees:

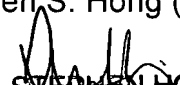
William L. Bashore

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Primary Examiner
Tech Center 2100

Doug Hutton

/Doug Hutton/
Supervisory Patent Examiner
Technology Center 2100

Stephen S. Hong (SPE)

A handwritten signature in black ink, appearing to read 'Stephen S. Hong', with a long horizontal line extending from the end of the signature.

STEPHEN HONG
SUPERVISORY PATENT EXAMINER